

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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In re Application of Evan E. Koslow ) Group Art 1791  
: ) Unit:  
Serial No.: 10/666,878 )  
Filing Date: September 19, 2003 ) EXAMINER: José A. Fortuna  
For: INTEGRATED PAPER )  
COMPRISING )  
FIBRILLATED FIBERS AND )  
ACTIVE PARTICLES )  
IMMOBILIZED THEREIN )

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**APPELLANTS' REPLY BRIEF**

This is a combined Request to Reopen Prosecution and Reply responsive to  
the Examiner's Answer mailed June 24, 2008 in the above-referenced appeal.  
Please charge any over or under payment to Deposit Account No. 04-0566.

## STATUS OF CLAIMS

The Examiner has concurred with Appellant's identification of the status of the claims, which is described in detail in Appellant's Brief.

In summary, the subject application was filed September 19, 2003 with claims 1-40, of which claims 1-25 were elected due to a Restriction. Appellant amended claims 1, 3, 4, 8, 9, 11, 13-15, 17, 20, 21, 23, 24, canceled claims 25-40 and added claims 41-43 in an Amendment filed on August 24, 2006, which was responsive to a Non-Final Rejection and two Office Communications. A Final Rejection was issued, in which response thereto Appellant filed an Amendment amending claims 8, 13, 14, 15, 21, 23, 24, and 41.

A Request for Continued Examination was mailed in response to an Advisory Action. A Non-Final Office Action was issued to which Appellant filed a response amending claims 1, 9, 11, 14, 20, 24, 42 and 43, canceling claims 8, 13, 15, 21, 23 and 41, and adding new claims 44-47. A Final Rejection was issued, an Amendment After Final Rejection was filed, an Advisory Action issued, and then Appellant filed the foregoing Appeal on February 7, 2008.

The claims currently on Appeal are claims 1-7, 9-12, 14, 16-20, 22, 24, and 42-47.

**GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

In the Examiner's Answer, the Examiner concurred with the issue on appeal which is the final rejection of claims 1-7, 9-12, 14, 16-20, 22, 24 and 42-47 under 35 USC §103(a) over Giglia et al. (U.S. 4,929,502) in view of Sawan et al. (U.S. 5,817,325) for the reasons set forth in the Office Action mailed April 17, 2007.

**REASONS FOR REQUEST TO REOPEN PROSECUTION  
AND  
ARGUMENT**

As discussed above, and in detail in Appellant's Brief, a Non-Final Office Action dated April 17, 2007 was mailed in response to Appellant's Request for Continued Examination. In such Non-Final Office Action, the Examiner rejected claims 1-7, 9-12, 14, 16-20 and 22 under 35 USC §103(a) as anticipated by Giglia et al. U.S. Patent No. 4,929,502 (hereinafter referred to as "Giglia") and rejected claims 8, 15, 21, 23-24 and 41-43 under 35 U.S.C. 103(a) as being unpatentable over Giglia in view of Sawan et al. US Patent No. 5,681,468 (hereinafter referred to as "Sawan '468") or Sawan et al. US Patent No. 5,817,325 (hereinafter referred to as "Sawan '325"). In response thereto, Appellant filed an Amendment wherein claims 1-7, 9-12, 14, 16-20, 22, 24 and 42-47 remained pending.

The Examiner then issued a Final Rejection dated October 16, 2007, wherein the above pending claims were rejected under 35 USC §103(a) over Giglia in view of Sawan '325 for the reasons set forth in the Non-Final Office Action dated April 17, 2007. Again, it is this final rejection of claims 1-7, 9-12, 14, 16-20, 22, 24 and 42-47 over Giglia in view of Sawan '325 that is now on appeal, as has been recognized by the Examiner.

Appellant submits that during the course of deciding whether to proceed with prosecution of the foregoing application by filing a second Request for Continued Examination, or Appeal the Final Rejection, appellant relied on the

Examiner's Final Rejection. In particular, in the Non-Final Office Action dated April 17, 2007 both Sawan '468 and Sawan '325 were cited in substantive rejections. Appellants argued in its response thereto, and continue to submit, that Sawan '468 is limited to filters that are coated on at least one surface and partially within a plurality of its pores with a metallic material. (Abstract and col. 2, ll. 11-15 and 54-67.) This metal coating of Sawan '468 has a uniform thickness on the surface and within the pores of the filter. (See, Col. 6, ll. 42-57, Col. 9, ll. 44-52, and *See*, Examples 2-5 and 10). Likewise, Appellant argued and continues to submit that Sawan '325 is also directed to antimicrobial contact-killing coatings on a substrate or freestanding antimicrobial films. (Col. 4, ll. 9-41 and col. 8, ll. 41-43.) The Examiner has even recognized the similarities between Sawan '468 and Sawan '325.

Bearing the foregoing in mind, when the Examiner withdrew the rejection over Giglia in view of Sawan '468 in the Final Rejection Office Action, Appellant respectfully believed that since this rejection had been overcome, and since the like Sawan '468 and Sawan '325 patents were cited for the same limitations, then the rejection over Giglia in view of Sawan '325 should also have been overcome. Hence, Appellant filed the present Appeal in light of the Examiner's actions in the Final Rejection dated October 16, 2007.

However, in the Examiner's Answer, the Examiner is now reasserting the rejection of the pending claims over Giglia in view of Sawan '325 and Sawan '468, along with other newly cited references. It is Appellant's position that he

Examiner's Answer rejection constitutes a new ground of rejection since it was believed that the previously cited Sawan'468 patent had been overcome. *See*, MPEP §1207.03.

As such, it is submitted that Appellant has not been given a given a fair opportunity to react to the Final Rejection since Appellant relied on the Examiner's withdrawal of Sawan '468 by expending the time, money and effort into filing an Appeal with the understanding that since Sawan '468 had been overcome in the Final Rejection, then the rejection over the like Sawan '325 patent should also have been overcome in the Final Rejection. *Id.*, *See*, *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976).

It is for these reasons that Appellant requests that the Examiner reopen prosecution to provide Appellant with a full and fair opportunity to respond to the Rejection over Giglia in view of Sawan '325 or Sawan'468.

As for the rejection of the present invention over Giglia in view of Sawan '325, and now Giglia in view of Sawan'468 in the Examiner's Answer, Appellant continues to submit, and the Examiner continues to acknowledge that Giglia fails to teach the interception-enhancing agent as claimed and cites both Sawan '325 and Sawan'468 to overcome this deficiency (*see*, Examiner's Answer).

Appellant continues to submit that neither Sawan patent, alone or in combination overcomes the deficiency of Giglia since neither Sawan patent teaches a microbiological interception enhancing agent on at least a portion of at least some of the fibers and/or active agents of the integrated paper.

Again, Sawan '468 discloses coating a filter with a carbonyl compound or with an activator followed by contact with a solution containing metal salt and an amine-containing compound to deposit the metal coating on the filter surface and within pores of the filter. (Col. 4, II. 7-24, col. 9, II. 10-16; col. 10, II. 9-52; Examples 2-5, 6A, 6B, 10 and 12 at col. 11, l. 40 to col. 15, l. 34.) This metal coating preferably has a uniform metal coating thickness on the surface and within the pores of the filter. (Col. 9, II. 44-52.) The precipitation of Sawan '468 is an uncontrolled precipitation of metal to form a uniform metal coating on a surface, and as such, would not provide the results of the controlled precipitation of the present invention, which is an integrated paper of a plurality of fibrillated fibers and active agents immobilized within the integrated paper, whereby a microbiological interception enhancing agent resides on at least a portion of at least some fibrillated fibers and/or active agents, such that this microbiological interception enhancing agent is also immobilized within and throughout the integrated paper.

Like that of Sawan '468, Sawan '325 is also limited to a contact-killing coatings or layers on a substrate or freestanding antimicrobial films (not attached to a substrate). (Col. 4, II. 9-32.) The compositions of Sawan '325 are applied to various substrates to form an organic matrix thereon that is then contacted with a biocidal material to deposit the biocidal material into the matrix to form antimicrobial coatings or layers on the substrates. (Col. 4, II. 33-41; col. 5, II. 3-7; col. 8, II. 41-43; and col. 9, II. 44-46.) Alternatively, the organic material and

the biocidal material may be combined in solution and then applied to the substrate to form the matrix. (Col. 5, ll. 8-20 and col. 9, ll. 44-46.) As another embodiment, a freestanding antimicrobial film may be formed using the antimicrobial material of Sawan '325. (Col. 5, ll. 37-59 and col. 8, ll. 41-43.) Sawan '325 does not disclose, contemplate or suggest an integrated paper made of a plurality of fibers and active agents immobilized within the integrated paper, whereby a microbiological interception enhancing agent resides on at least a portion of at least some fibrillated fibers and/or active agents, such that this microbiological interception enhancing agent is also immobilized within and throughout the integrated paper, as in the present invention.

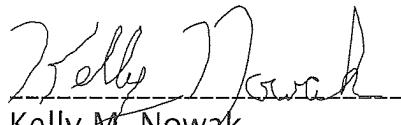
Accordingly, Appellant submits that the structures of the present invention are different from that of the cited references, such that, the cited references, either alone or in any proper combination thereof do not anticipate nor render obvious the present invention.

In the Examiner's Answer, the Examiner recognizes that Giglia fails to teach the use of lyocells as the synthetic fibers used to make the paper, and cites the new prior art reference of the Celanese publication to overcome this deficiency. Appellant submits that since the Celanese publication is cited for the first time in an Examiner's Answer, it introduces a new ground of rejection, and as such, prosecution on the merits should be reopened. *See, MPEP §1207.03; In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970).*

For the reasons as discussed above, Appellant respectfully requests that the Examiner withdraw the Final Rejection and either issue a notice of allowance, or in the alternative, reopen prosecution on the merits to apprise Appellant with a fair and full opportunity to respond to the outstanding rejections in the Examiner's Answer.

In the event the Examiner denies Appellant's request, Appellant respectfully requests that the Board overrule the Examiner's rejections and/or reopen prosecution on the merits to apprise Appellant with a fair and full opportunity to respond to the outstanding rejections.

Respectfully submitted,



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